

Paper No. 27  
EWH/cj

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      JUNE 9, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re William Carroll

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Serial No. 74/643,905

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William Carroll, pro se.

Florentina Blandu, Trademark Examining Attorney, Law Office  
106 (Mary Sparrow, Managing Attorney)

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Before Seeherman, Hanak and Chapman, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

William Carroll (applicant) seeks to register DISKBOOK  
in typed drawing form for "a series of books and CD-roms,  
sold as a unit, all on the subjects of travel, historical  
walking tours, and tourist information." The intent-to-use  
application was filed on March 9, 1995.

The Examining Attorney has refused registration on two  
grounds. First, the Examining Attorney contends that

pursuant to Section 2(e)(1) of the Lanham Trademark Act, applicant's mark DISKBOOK is merely descriptive of his goods. Second, citing Trademark Rule 2.72(a), the Examining Attorney has refused registration on the basis that applicant is impermissibly attempting to amend its drawing to depict its mark as CODA DISKBOOK, as opposed to simply DISKBOOK. It is the contention of the Examining Attorney that such a proposed amendment to the drawing constitutes a material alteration and hence is not permitted.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

As has been stated repeatedly, "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) and cases cited therein.

In support of her contention that applicant's mark is merely descriptive of applicant's goods, the Examining Attorney has made of record ten stories from the NEXIS

database which demonstrate to our satisfaction that the term "diskbook" is indeed descriptive of a type of CD-rom, one of applicant's goods. The following passage taken from the October 1994 issue of "Technological Horizons in Education" presents a good description of what a diskbook is:

Creating textbooks on disk is one of the most challenging opportunities for applying technology and education. Traditional textbooks present information as Gutenberg did - serially, in page order. New technologies, such as hypertext tools and CD-ROM, make it possible to access information in many different ways, tailored both to subject and user. Diskbooks can store not just information, but also software that manages its presentation and enables the reader to interact with it in a personal fashion.

An article from the April 6, 1995 edition of "The Dallas Morning News" discusses an exhibit at the Dallas Public Library and demonstrates that the terms "diskbook" or "discbook" (spelled either as one word or as two) are simply not obscure: "The exhibit will showcase the many changes that have transformed the book through the ages, beginning with a clay tablet from Babylonia (2095-2048 B.C.) through a contemporary compact disc book."

In arguing that his purported mark DISKBOOK is not merely descriptive of his goods, applicant makes the assertion that the Examining Attorney's stories exemplify "rare uses." (Applicant's letter dated September 28, 1996). We simply disagree. Besides being discussed in "The Dallas Morning News," diskbooks or disc books (spelled either as one word or as two) have been discussed in such other general circulation publications as "The Austin American Statesman," "The Virginian Pilot (Norfolk)" and "U.S. News and World Report."

In his September 28, 1996 letter, applicant also makes the following argument: "May I also point out that the proper use of the word/phrase in my application is DiskBook ... as typed here. Not disk book, disc book, diskbook, or discbook." Obviously, an applicant cannot convert a descriptive term into a trademark simply by the use of capitalization. Moreover, because the application depicts the mark in typed drawing form, a registration that issued would encompass the mark depicted as "diskbook."

Finally, we note that applicant himself appears to concede that his purported mark DISKBOOK is not, by itself, a source identifier. In this regard, we note that on the second page of applicant's letter of September 28, 1996, applicant requests that his trademark be changed from

DISKBOOK to CODA DISKBOOK. Applicant then explains that "this simple revision maintains my use of 'DiskBook' and by adding 'Coda' does in fact identify the source of the goods." In other words, applicant himself appears to concede that the real source identifier of his goods is CODA or CODA DISKBOOK, and not DISKBOOK by itself.

Accordingly, we find that DISKBOOK per se is merely descriptive of applicant's goods and we sustain the refusal to register pursuant to Section 2(e)(1) of the Lanham Trademark Act.

As for applicant's attempt to change his mark from DISKBOOK to CODA DISKBOOK, we find that this clearly constitutes an impermissible material alteration of the drawing. It must be remembered that applicant filed an intent-to-use application. With his original application, applicant submitted no specimens (obviously), but merely submitted a drawing which reflected the mark as DISKBOOK in typed drawing form. Thus, we are not dealing with a situation where, from the very beginning, there was an inconsistency between applicant's drawing and applicant's specimens of use because the latter simply did not exist when the application was originally filed. See In re ECCS Inc., 39 USPQ2d, 2001, 2004-05 (Fed. Cir. 1996).

We find that the addition of the arbitrary term CODA to the mark depicted in the drawing (DISKBOOK) would be an impermissible material alteration of the mark as filed.

Accordingly, the second ground of refusal is also affirmed.

Decision: The refusal to register is affirmed on both grounds.

E. J. Seeherman

E. W. Hanak

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board